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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,495	05/04/2001	Denis Khoo	40015980-0010	8842
909	7590	12/23/2003	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	KHOO ET AL.
Examiner	Art Unit
Khanh H. Le	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 10/18/2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 28-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 28-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other: \_\_\_\_\_

### **Final Action**

1. This is in response to the response dated October 18, 2003.  
Claims 28-41 are added. Claims 1-11, 13-28, ( which are actually 1-27), are cancelled. An interview summary of the interview on October 21, 2003 is attached.

### **Remarks**

- 2a. Previous objections to claim 12: withdrawn as moot.
- 2b. Applicants remarks re. prior art rejections are moot as new prior art is applied.

### **Restriction**

3.During a telephone conversation with Mr. James Jakobsen, on January 28, 2003, an election was made without traverse to prosecute the invention of Species I, claims 1-6, 14-19. Applicant has affirmed this election. The present new claims substantially replacing 1-6, 14-19 are acceptable.

### **35 USC 112**

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

5. As to claim 16:Withdrawn as moot.

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6. **Claims 33-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

The Examiner has not been able to find clear support in the specifications for claim 33-34. In response to this office Action, please point out the specific support for these claims, by page, line numbers or alternatively, make required amendments.

Claim 33.

Nowhere is the choice compensation based on the cost of the content disclosed.

Claim 34.

“quality “ is undefined in the Specifications. According to Merriam Webster Online (<http://merriamwebster.com/cgi-bin/dictionary>), in the present context, “quality” most reasonably should mean

1 a : peculiar and essential character

4 a : a distinguishing attribute

Claim 34 is only supported by the following specification:

*“In another embodiment, the content is automatically sent to the user based on prior viewing habits”.*

Therefore, without a “distinguishing , peculiar or essential “ trait, the ”quality of the content” could not be said to be disclosed as being based on the user viewing habit/demography though the content itself could be.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

As to claim 16: Withdrawn as moot.

8. **Claims 34 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 34.

Claim 34 is only supported as shown above . Therefore "quality of the content" is unclear in claim 34 and is interpreted as the content itself.

Applicants are required to clarify the scope of Claim 34 and/or make appropriate corrections.

Claim 39.

"the optional content" lacks antecedent basis. For art purposes, " the optional content to be provided with advertisement" is interpreted as the advertisement.

Claim 39 is further ambiguous. It is not clear how the ad varies with the user preference/habit so that the quantity of ad is matched to the quality or cost of the content provided. Thus claim 39 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants are required to clarify the scope of Claim 39 and/or make appropriate corrections.

#### **Claim Rejections - 35 U.S.C. § 101**

9. Withdrawn as moot due to claims cancellations.

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**11. Claims 28-36, 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan US 5721827 A.**

Logan discloses:

Claim 28. A method of a content provider for providing a content comprising digitalized entertainment media, excluding advertisements, over a data network to a viewer/user, the content being offered with an option, comprising:

offering to provide, over a data network from a content provider to a viewer/user, a content associated with an option of making a choice (abstract)  
on a content-by-content basis (abstract: selected programming; col 7 l. 13-45, Figs 2, 4 ,especially items 301, 303, 307, Fig. 5 and associated text, cols. 15-16)  
to accept either a content without advertisement for which the viewer/user would pay a choice compensation to the content provider, or  
accept a content with advertisement for which the viewer/user would not pay the choice compensation to the content provider (abstract, col 12 l. 4-8: during playback of a content sequence( see Fig 5), acceptance by actually playing an ad is monitored and accounted for, col 14 l. 6-10).

As to claims 29 and 31,

Logan discloses: wherein the data network comprises a content display device (see at least Fig 1 item 118 and associated text).

Claim 30.

Logan discloses: wherein the data network comprises a content module (see at least Fig 4 items 315 “content providers” table , 303 “ programs” table, and associated text).

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As to claims 32 and 38

Logan discloses: wherein the option is offered to a viewer/user comprising an individual viewer/user ( abstract: “ subscriber” ).

Claim 33.

Logan discloses: wherein the choice compensation is based on the quality or cost of the content ( col 26 l. 53-col 27 l. 8 ) .

Claim 34.

Logan discloses: The method of claim 33, wherein the quality (nature) of the content is based on the viewing habit or demography of the viewer/user. (abstract l. 2-5; col 7 l. 45-50, col 6 l. 47-60; Fig 6 item 408 “match?” and associated text; col 9 l. 23-50).

Claim 35.

Logan discloses: wherein the viewer/user chooses the content with or without advertisements by transmitting the choice over the data network to the content provider (abstract, 4<sup>th</sup> sentence from last; col 4 l. 2-8; col 26 l. 53-59 ) .

Claim 36. ,

Logan discloses: wherein the choice compensation is a fee assessed on the basis of the choice content payable to the content provider by the viewer/user (abstract : “subscriber fee”; col 26 l. 53-col 27 l. 8;col 17, col 27 l. 2-30) .

Claim 39.

In Logan the ads are matched to the content delivered which is based on the user’s demographics, habit/preferences (see at least col 7 l. 45-65, col 9 l. 22-60). Further the Logan user selects (matches) the ads in sufficient quantity to offset the costs as he/she wishes ( col 9 l. 50 – col 10 l. 6). Therefore Logan discloses “ wherein the optional content to be provided with

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advertisement varies with the demographic profile of the individual viewer/user viewing habit or preference so as to match quantity of advertisement with the quality or cost of the content provided”.

Claim 40. A system for a content provider providing to a viewer/user over a data network a content with an offer of an option, comprising (see at least Fig. 1 and associated text) :  
a content display device for displaying content comprising digitalized entertainment media, excluding advertisements (see at least Fig. 1, items 103, 105, 118 and associated text);  
a content storage device for storing content (see at least Fig. 1, items 131-137 and associated text); and

a content server having a processor for communicating with the content display device and the content storage device wherein the content storage device has computer instructions stored thereon for loading content into a computer so as to cause the computer to perform a method program of providing to a viewer/user over the data network the content with the option of allowing the viewer/user a choice between viewing a content having a program devoid of advertisement for which compensation is due, and viewing a content having a program containing an advertisement for which compensation is not due, and for communicating the selected option to the content provider (see at least Fig. 1 and associated text; col 12 l. 4-23; col 4 l. 6-10; col 26 l. 53-59) and providing the content based on the selected option from the content provider to the viewer/user ( col 12 l. 4-23; col 4 l. 6-10; col 26 l. 53-59).

Claim 41. wherein the data network is connected to an electronic computer readable medium for storing and transmitting instructions as to content and option selection (see at least cols. 10-12).

Claims 40-41 essentially parallel claim 1 in system, computer readable medium and electronic computer instructions formats and are rejected on the same basis

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. **Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan US 5,721, 827 A.**

Claim 37.

Logan discloses an option comprising a choice to the viewer/user of selecting the content together with an embedded (added, inserted ) advertisement for reduced fees (col 27 l. 3-6, Fig. 5 and associated text; col 9 l. 50 – col 10 l. 6) . Further the Logan user selects (matches) the ads in sufficient quantity to offset the costs as he/she wishes ( col 9 l. 50 – col 10 l. 6).

Logan specifically does not disclose an option whereby the content is 100% subsidized (“ an option... for which the choice compensation is not paid to the content provider). However at col . 9 l. 66- col 10 l. 6, Logan discloses an user indicating a net charge at the desired level, based on which the amount of advertising is adjusted. It is well-known some consumers desire free service or 100% subsidies. Therefore it would have been obvious to one skilled in the art at the time of the invention to add to Logan’s teaching of an user indicating a net charge at the desired level, based on which the amount of advertising is adjusted, an net charge of zero, to achieve 100% subsidy, to satisfy such desire of certain consumers.

**Conclusion**

14. Prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

Goldhaber et al, US 5794210, discloses user compensation for experiencing ads.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

KHL  
November 14, 2003  
KHL

JAMES W. MYHRE  
PRIMARY EXAMINER